REMARKS / ARGUMENTS

This application is believed to be in condition for allowance because the claims are believed to be non-obvious and patentable over the cited references. The following paragraphs provide the justification for this belief. Therefore, in view of the following reasoning for allowance, the applicants hereby respectfully request further examination and reconsideration of the subject patent application.

1.0   Rejections Under 35 U.S.C. §103(a):

The Office Action of March 2, 2005 rejected claims 1-4, 7-15, 17-19, 23, 27-28, 31-39, 42, 45-47 and 55 under 35 U.S.C. §103(a), as being unpatentable over Smith, et al., (U.S. Patent No. 5,923,327, hereinafter "**Smith**") in view of "Screen Dumps of Microsoft Windows Version 4.0 ("**MS Win**").

However, in order to deem the Applicant's claimed invention unpatentable under 35 U.S.C. §103(a), a prima facie showing of obviousness must be made. However, as fully explained by the M.P.E.P. Section 706.02(j), to establish a prima facie case of obviousness, three basic criteria must be met. First, *there must be some suggestion or motivation*, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, *to modify the reference* or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, *the prior art reference (or references when combined) must teach or suggest all the claim limitations*.

Further, in order to make a prima facie showing of obviousness under 35 U.S.C. 103(a), all of the claimed elements of an Applicant's invention must be considered, especially when they are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie case of obviousness exists. The Federal Circuit court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in

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the claimed system and its purpose was not taught therein (*In Re Fine*, 837 F.2d 107, 5 USPQ2d 1596 (Fed. Cir. 1988)).

The Applicants will show in the following discussion that the cited references fail to teach or render obvious several of the claimed elements of the Applicants claimed invention. Consequently, in view of the following discussion, the Applicants respectfully traverse the rejection of claims 1-4, 7-15, 17-19, 23, 27-28, 31-39, 42, 45-47 and 55 under 35 U.S.C. §103(a) over *Smith* in view of *MS Win*.

1.1   Rejection of Claims 1-4, 7-15, 17-19, and 23:

The final Office Action reiterates the arguments that were presented in the prior Office Action of June 17, 2004, and responds to the Applicants arguments for patentability over the cited art. However, Applicants respectfully suggest that the Office Action continues to misinterpret the Applicants claimed invention in view of the cited art, and that the disclosed references fail to teach the elements for which they are offered.

1.1.1   Point (a) of the "Response to Arguments" presented in the Office Action:

In point (a) of the "Response to Arguments" presented on pages 22-23 of the present Office Action, the Office Action continues to equate information such as the name "*BRIAN BEATON*", as illustrated in fig. 15B of the *Smith* reference with the Applicants claimed "data objects." However, it should be noted that Applicants specifically define "data objects" on page 13, lines 23-26 as follows:

> "By way of example, *data objects are, in a basic sense, variables for holding information*, such as, for example, an email address, phone number, or birthday for a contact in an electronic address book, or any other information that can be categorized and stored in a database or other electronic data source." (emphasis added)

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In other words, applicants are describing and claiming a system wherein particular data objects (i.e., actual variables, not merely the *content* of those variables) are arranged as a function of priority, so long as those variables are populated with some content. In this manner, the data in more important variables (higher priority) is displayed prior to the information in less important variables (lower priority), regardless of the content of those variables.

In stark contrast, the name "*BRIAN BEATON*", as illustrated in fig. 15B of the *Smith* reference appears to represent the *contents* of a name type variable. *Smith* clearly describes an alphabetic sort of names (presumably stored in some type of name variable, array, or database) which are then displayed in some type of predefined display. However, *Smith* does *not* describe a priority based arrangement of the data objects representing those variables. In other words, the name "*BRIAN BEATON*" will *always* appear in the same place in the fixed display disclosed by the *Smith* reference because some software programmer determined what that position should be when writing the software code enabling the system disclosed by the *Smith* reference. Again, the various names stored by the *Smith* system may be sorted alphabetically. However, the position of the variables containing those various names will never change in the fixed display disclosed by the *Smith* reference.

Therefore, the *Smith* reference does *not* disclose "*automatically associating a priority with each data object in a set of data objects*" because an alphabetic sort of information contained in a variable which itself is displayed in a *predetermined fixed position* is *not*, and can not be, a priority based arrangement of data objects representing *variables for holding information*. Clearly, a variable in a *permanently fixed position*, as disclosed by *Smith*, can *not* be arranged. Consequently, there can not be any priority associated with such variables that determines a non-existent arrangement of those variables. In other words, the *position* of the actual variables ("data objects") disclosed by the Applicants are arranged when being displayed, as a function of the priority associated with those data objects, while *Smith* provides a system which merely sorts information in variables and then displays those variables in fixed predetermined positions.

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It should be noted that the Office Action partially, but incorrectly, addressed this point by stating in point (a) of the "Response to Arguments" presented on page 23, lines 3-6 that:

> "Smith teaches displaying data objects wherein ***the priority automatically associated with each data object is inherent to the layout*** as proven by the displayed arrangement of the data objects and their relative location and distance from each other." (emphasis added)

Applicants respectfully suggest that this interpretation of the **Smith** reference is in error. In particular, the interpretation quoted above is basically a restatement of the arguments presented by the Examiner in an Examiner Interview on March 8, 2004, between the Examiner and Attorney for Applicants, as previously discussed in the Applicants response dated April 12, 2004.

In the aforementioned Examiner Interview, the Examiner's stated position was that **Smith** described a "***set arrangement to be displayed such that the name field is a precursor to the number field.***" Examiner explained that this ***set arrangement*** was the same as the Applicants claimed system for "***automatically arranging** the position of displayed data objects **based on a priority associated with each data object...***" The Examiner further explained that both the name field and the number field described by **Smith** included an ***associated priority*** because the computer programmer who wrote the software code enabling the **Smith** system had determined that the ***name field*** should be permanently placed in front of the ***number field*** in the "***set arrangement***," and that this determination gave a "priority" to each of the name and number fields. Note that this argument is clearly in agreement with the Examiner's statement in the current Office Action that "***the priority automatically associated with each data object is inherent to the layout.***"

However, as previously explained by the Applicants, the Examiner has admitted that **Smith** discloses a "***set arrangement.***" Consequently, a computer programmer's

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determination of how to *prearrange data fields* in that *set arrangement* can not reasonably be considered to teach "*automatically associating a priority with each data object in a set of data objects*," with that priority then being used to automatically arrange those data objects, as disclosed and claimed by the Applicants. Consequently, Applicants respectfully suggest that the interpretation of the *Smith* reference offered by the Office Action in point (a) is in error. As such, any rejections based on this misinterpretation of the *Smith* reference must be vacated.

1.1.2 Point (b) of the "Response to Arguments" presented in the Office Action:

Next, in point (b) of the "Response to Arguments" presented on pages 23-24 of the present Office Action, the Office Action again states that "Smith teaches dynamically populating the display device by arranging a position of data objects within the visible area of the display device beginning with a data object having a highest priority..."

Clearly, as explained above with respect to point (a), *Smith* does not, and can not, dynamically arrange data objects, since the variables in the *Smith* reference are displayed in set, fixed, predetermined positions. Consequently, Applicants respectfully suggest that the interpretation of the *Smith* reference offered by the Office Action in point (b) is in error. As such, any rejections based on this misinterpretation of the *Smith* reference must be vacated.

The Office Action the continued in point (b) by suggesting that:

"The teachings extracted from MS Win is for the feature of *automatically associating a priority with each data object in a set of data objects*; dynamically populating the display device by arranging a position of data objects within the visible display area of the display device beginning with a data object having a highest priority wherein the automatically arranged position of the data objects within the visible display area is not predefined (figs. 1-4)." (emphasis added).

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It should be noted that in the above quoted response, the Office Action failed to respond to the Applicants prior traversal of the assertion that the **MS Win** reference teaches "**automatically associating a priority with each data object in a set of data objects**," as disclosed and claimed by the Applicants.

In particular, in the Applicants prior response, Applicants explained that with respect to the argument presented by the Office Action that **MS Win** teaches the Applicants claimed element of "dynamically populating the display device by automatically arranging a position of at least one data object within a visible display area of the display device beginning with a data object having a highest priority," the Office Action argues that "*selecting 310, "Arranging icons > by Name", allows data objects to be automatically arranged with the visible display area of the display device beginning with a data object having the highest priority 410, "bcbs1"."* In other words, the Office Action argued that performing a **manually ordered** alphanumeric sort (i.e., "*Arranging icons > by Name*") is equivalent to the Applicants' claimed element of "... **automatically arranging** a position of at least one data object... beginning with a data object **having a highest priority**." (emphasis added)

However, in stark contrast to the position advanced by the Office Action, and as discussed previously with respect to the **Smith** reference, a manually initiated alphanumeric sort of the information within particular data fields (or Icons in the case of the **MS Win** reference) fails completely to teach or in any way disclose providing a **priority-based arrangement of data objects**, each of which has an **automatically associated priority**. Again, a manually ordered alphanumeric sorting and arrangement of Icons is simply **not** a priority-based arrangement of data objects within the visible area of a display device. Further, in contrast to the position advanced by the Office Action, the Icons of the **MS Win** reference **do not have an associated priority**.

In other words, the Office Action is offering manually ordered Icon sorts as teaching "**automatically associating a priority with each data object in a set of data objects**." However, it should be noted that the sort is based on the **content** of each Icon, rather than

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on any priority associated with the Icon itself. For example, any two Icons representing a "shortcut" to any two unique files will be identical except for the information contained within those icons. Consequently, each Icon can be roughly equated to a "variable" that contains pointers to a particular file, and in some cases additional metadata regarding each of those files.

For example, if one **MS Win** Icon represents a pointer to a file named "a.doc" and a second Icon represents a pointer to a file named "b.doc" then a manually ordered alphabetic sort (e.g., in figs. 1-4; *selecting 310, "Arranging icons > by Name"*) will place the "a.doc" Icon before the "b.doc" Icon. Clearly, this sort, and thus the subsequent arrangement of the Icons in the display device, is being performed as a function of the **content of the variable** represented by the Icon, rather than based on any priority associated with the Icon itself.

In contrast, as explained above, Applicants are describing and claiming a system wherein particular data objects (i.e., actual variables, not the **content** of those variables) are arranged as a function of priority associated with the data objects, so long as those variables are populated with some content. In this manner, the data in more important variables (higher priority) is displayed prior to the information in less important variables (lower priority), **regardless of the content of those variables**. In other words, **MS Win** sorts and arranges the Icons as a function of the content of those Icons. In stark contrast, the claimed invention arranges data objects based on a priority associated with those data objects **regardless of the content of those data objects** (so long as the data objects contain data). Note that not only is this interpretation of the claimed invention fully supported by the text of the specification, it is the only reasonable interpretation of the claimed invention in light of the detailed description of "data objects" noted above.

For example, as explained on page 13, lines 23-26 of the detailed description of the claimed invention:

"By way of example, *data objects are, in a basic sense, variables for holding information*, such as, for example, an email address, phone number, or birthday for a contact in an electronic address book, or any other information that can be categorized and stored in a database or other electronic data source." (emphasis added)

Further, it should also be clear that the priority associated with the Applicants claimed data objects is *separate* from the content of those data objects. For example, on page 15, lines 9-29, of the Applicants detailed description, Applicants describe one example of the use of priorities with respect to "data objects" used to populate an electronic "address book" type display:

"Still another example of a prioritized data set includes specific information relevant to one or more contacts in an electronic address book. Examples of such specific information includes items such as, for example, a contact name, an email address, a home, work, fax, pager or cell phone number, a contact home or business address, a contact birthday, or any other information that may associated with a contact in the address book. *Each of these specific information items, or data objects, is preferably assigned a priority* using one of the above-described methods, i.e. predefined priority list, dynamic priority list, or user specified/modified priority list. For example, priorities for specific data object types may simply be predefined based on a presumed order of importance for each data object type. Consequently, a contact email address may be given the highest priority, followed in decreasing order of priority by a contact home telephone number, a contact home address, a contact birthday, a contact business phone number, etc. Clearly, any desired order of priority may be associated with such data objects. Alternately, in using a dynamic priority list, priority is based on frequency of use or access by a user. Consequently, in such an embodiment, the prioritized data module 410 simply keeps a count of how often a user makes use of a particular data object type for contacts in the address book, such as, for example, a contact email address

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or contact home phone number. Using this count, the prioritized data module 410 then automatically assigns increasing priorities to data objects in order of increasing use for those data object types." (emphasis added)

Again, it should be clear that the priorities are not a function of the content of the data objects, but are instead a function of the relative importance of each data object. In contrast, as explained above, the different Icons of the *MS Win* reference are basically the same variable (with the primary difference being pointers to different files and possibly different metadata). Arrangement of the *MS Win* Icons is therefore performed as a function of the content of those Icon variables. Consequently, because manually ordered sorts based on the *content* of two or more variables does not associate a priority with the claimed "data objects," it should be clear that the *MS Win* reference fails completely to disclose "*automatically associating a priority with each data object in a set of data objects.*"

1.1.3 Point (c) of the "Response to Arguments" presented in the Office Action:

Next, in point (c) of the "Response to Arguments" presented on page 24 of the present Office Action, the Office Action again states:

> "MS Win does teach that the automatically arranged position of data objects within a visible display area is not predefined (figs. 1-4; *populating the display device with "New Data Object" 110 and selecting 310, "Arranging icons > by Name", allows data objects to be automatically arranged with the visible display area of the display device beginning with a data object having the highest priority 410, "bcbs1", wherein the* <u>automatically arranged position is not predefined but defined upon selecting 310</u>)."

It should be noted that the Office Action failed completely to respond to the substance of the Applicants traversal of this point, except for a verbatim restatement of the original assertion made by the previous Office Action. The MPEP requires the Examiner to

respond to the substance of the Applicants arguments whenever a traversal of the any rejection is made. Therefore, Applicants have not been afforded an adequate forum in which to respond to this particular point, as the Office Action failed to reply to any of the Applicants arguments with respect to this point. For these reasons, the arguments presented previously by the Applicants will again be presented below.

In particular, the Office Action argues that the **MS Win** reference teaches that *"the automatically arranged position is not predefined but defined upon selecting 310..."* In other words, the Office Action is arguing that the creation of Icons described by the Office Action with respect to Figs. 1-4 of the **MS Win** reference teaches that "the automatically arranged position of data objects within the visible display area *is not predefined*," as disclosed and claimed by the Applicant.

However, the Applicants respectfully suggest that the Office Action has mischaracterized the **MS Win** reference. In particular, in stark contrast to the position advanced by the Office Action, the Applicants respectfully suggest that the **MS Win** operating system **automatically arranges newly created Icons** within a folder window, such as the one shown, **within a grid pattern by default**. However, where a user has **deselected** the *"Arrange Icons > Auto Arrange"* option, icons that are created by dragging and dropping an object into the folder window will simply be placed **exactly** where the user manually drops that object. In other words, in this case, the user is predefining the position of particular Icons. **Note that this manual arrangement has no automatically assigned priority whatsoever.** It should also be noted that Icons that are created by means other than dragging and dropping will still be arranged in the **predefined** grid pattern by default, even where the *"Auto Arrange"* option is deselected.

Consequently, the positions of the icons within the **MS Win** folder windows are, when first created, either **automatically arranged within a grid in the order they are created** or simply manually placed in **specific locations** that are predefined by the user within the window if the "Auto Arrange" option is disabled. Therefore, the icon position is either **predefined** based on the grid layout which automatically places the Icon in the next

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available grid spot, *whether or not that grid spot is visible in the window,* or the position is *predefined* by *user selection of the exact spot* within the window where the icon is dropped. Therefore, it should be clear that the *MS Win* reference fails completely to teach or in any way disclose that "the automatically arranged position of data objects within the visible display area *is not predefined,*" as disclosed and claimed by the Applicant.

1.1.4 Point (d) of the "Response to Arguments" presented in the Office Action:

Next, in point (d) of the "Response to Arguments" presented on page 24 of the present Office Action, the Office Action states:

> "... the modified MS Win does teach continuing to dynamically populate the display device by continuing to automatically arrange a position of one or more of the data objects having a next highest priority until available space within the visible display area of the display device has been filled with data objects (MS Win: figs. 1-4; the data objects are populated until available space within the visible display area of the display device has been filled with data objects). Applicant's assertion that MS Win will continue to populate the non-visible display area with data objects seems to rely on a scenario wherein data objects exceeds visible displayed space and does not preclude a scenario wherein the data objects are populated until available space within the visible display area of the display device has been filled by objects as claimed."

In response, Applicants' respectfully suggest that the two "scenarios" offered by the Office Action as supporting the teaching of the claimed feature relating to "continuing to dynamically populate the display device by continuing to automatically arrange a position of one or more of the data objects having a next highest priority *until available space within the visible display area of the display device has been filled with data objects*" (emphasis added) amount to a mischaracterization of the *MS Win* reference.

In particular, the Office Action suggests that "Applicant's assertion that MS Win will continue to populate the non-visible display area with data objects... does not preclude a scenario wherein the data objects are populated until available space within the visible display area of the display device has been filled by objects as claimed." However, this scenario is in fact precluded in **MS Win**.

Specifically, as previously explained by the Applicants, it is well known that many more icons can be added to a folder window than will fit within the visible display window of the folder windows of the **MS Win** reference. In fact, as illustrated by Figs. 2-6 of the **MS Win** reference, as soon as the icons will not fit within the visible area of the display window, **scroll bars** are added to the window to allow the user to scroll through the icons within the window. Consequently, rather than continuing to populate the window only **"until available space within the visible display area of the display device has been filled,"** as disclosed and claimed by the Applicants, the **MS Win** reference will continue long past this point by simply populating non-visible areas of the display which are then available for viewing through the use of the scroll bar.

Further, it should be noted that the Applicants claim "**automatically**... dynamically populate the display device... **until available space within the visible display area of the display device has been filled with data objects**." However, as noted above, in stark contrast to the position advanced by the Office Action, **MS Win** is specifically designed automatically add scroll bars to a window so that Icons can be added to **non-visible portions** of a display window. Clearly, it is possible that given a large enough display window and only few Icons, there won't be sufficient Icons to fill the available space in the system taught by the **MS Win** reference. However, the actual claim language must be examined in interpreting the claim.

Specifically, the Applicants claim a system that is capable of **automatically** continuing to populate the window **until** the available space has been filled with data objects, at which point, further **automatic** population of the display area is **terminated**. **MS Win** fails completely to provide for any such automatic termination of window

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population based on a visible display area. Further, the "scenario" advanced by the Office does **not** provide **MS Win** with any such capability. In fact, unless a user **manually** terminates the addition of additional Icons when the display window is filled, any additional Icons will simply be added in the non-visible display area of that window. Consequently, it should be clear that the Office Action has mischaracterized the **MS Win** reference with respect to this claimed feature.

1.1.5 Patentability of Independent Claim 1:

In view of the preceding discussion, and in view of the Applicants prior response, filed 23 September, 2004, the subject matter of which is incorporated herein by this reference, the Applicants respectfully suggest that the suggested **Smith - MS Win** combination reference fails to teach several elements of the Applicants claimed invention with respect to independent claim 1. Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 1, as cited below. Therefore, the Applicants respectfully traverse the rejection of independent claim 1, and thus of dependent claims 2-4, 7-15, 17-19, and 23 under 35 U.S.C. §103(a) over **Smith** in view of **MS Win** in view of the non-obviousness of claim 1, and therefore request reconsideration of the rejection of claims 1-4, 7-15, 17-19, and 23 under 35 U.S.C. §103(a). In particular, claim 1 includes the following novel language:

"A system for automatically displaying data objects on a computer display device comprising:

automatically associating a priority with each data object in a set of data objects;

dynamically populating the display device by automatically arranging a position of at least one data object within a visible display area of the display device **beginning with a data object having a highest priority**;

> *wherein the automatically arranged position of data objects within the visible display area is not predefined*; and
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> *continuing to dynamically populate the display device by continuing to automatically arrange a position of one or more of the data objects having a next highest priority until available space within the visible display area of the display device has been filled with data objects*." (emphasis added)

1.2   Rejection of Claim 2:

The Office Action rejected claim 2 under 35 U.S.C. §103(a) over **Smith** in view of **MS Win** based on the rationale that the suggested combined reference teaches that "the priority associated with each data object is based on a pre-designated priority list." In particular, the Office Action first offers "list 320" of Fig. 3 of the **MS Win** reference as teaching a "pre-designated priority list."

In particular, in point (e) of the "Response to Arguments" presented on pages 24-25 of the present Office Action, the Office Action states:

> "MS Win does teach that the priority associated with each data object is based on a pre-designated priority list wherein the priority associated with each data object is <u>changeable</u> (MS Win: fig. 3, *list 320*; Smith: fig 12A; col 8, lines 25-28; *the priority associated with each data object is based on a pre-designated priority list such that selecting <u>another</u> option on the list changes the priority associated with each data object wherein the priority associated with each data object may be one of name, size, etc.*).

However, with respect to the **MS Win** reference, and in stark contrast to the position advanced by the Office Action, it should be clear that "list 320" of Fig. 3 of the **MS Win** reference fails to teach a "pre-designated priority list." In fact, the the Applicants respectfully suggest that the Office Action has again mischaracterized the **MS Win** reference with respect to "pre-designated priority list" feature.

In particular, list 320 of Fig. 3 of the *MS Win* reference merely provides for various sorting criteria, including: name sorts; size sorts, type sorts and date sorts. Clearly, icons representing particular files, shortcuts, etc., in the *MS Win* include various characteristics including, for example, a file name, a file type, a file size, and a creation date. However, none of this information constitutes an automatically assigned priority as described and claimed by the Applicants. Further, the mere capability to sort icons based on these identifying characteristics has nothing whatsoever to do with a list of pre-defined priorities. Plainly stated, a list of pre-defined priorities is not equivalent to a list of various criteria for sorting icons. Further, as described above, these sorts are based on the *content* of each Icon, rather than on any priority associated with the Icons themselves. Consequently, the *MS Win* reference fails to teach that "the priority associated with each data object is based on a pre-designated priority list."

Further, as indicated above, the Office Action also offers the *Smith* reference, Fig. 12A, and col. 8, lines 25-28 as disclosing the claimed "pre-designated priority list." However, as explained in the Applicants previous response, Fig. 12A, and col. 8, lines 25-28 of the *Smith* reference merely describe *populating* predefined fields, and possible manual selection of an "information icon," rather than associating any "priority" with those fields.

Specifically, Fig. 12A of the *Smith* reference merely illustrates a sample screen for creating an Electronic Business Card (EBC) using Caller ID (CLID) information received during a telephone call. This interpretation of Fig. 12A is fully supported by lines 25-28 of the *Smith* reference, as well as the text surrounding the lines offered by the Office Action to support this argument. For example, in col. 8, lines 24-33, *Smith* describes Fig. 12A as follows:

> "Referring to FIG. 12A, screen 1210 is an exemplary display, consistent with the present invention, of *when the user receives a call from a caller. CLID information, "Bobby Bonito" and "738-9157," appears in the name and number fields, respectively.* The user, while on the phone with the caller,

> *may select an information icon 1211 to display the EBC associated with the caller.* Upon selection, program 520 searches either the name or telephone field of stored EBCs to locate the match. If program 520 finds a match, program 520 displays the corresponding EBC." (emphasis added)

Clearly, as previously explained by the Applicants, *Smith* is describing populating *predefined* fields (i.e., the "name" and "number" fields) with information received from the CLID system. Further, *Smith* explains that the user can then *manually select* an "information icon" for displaying an Electronic Business Card associated with the person identified by the CLID system.

Therefore, the Applicants respectfully suggest that the reasonable interpretation of Fig. 12A; and col. 8, lines 25-28 is that *Smith* merely describes *populating* the predefined fields, and possibly manually selecting an "information icon," rather than associating any "priority" with those fields (e.g., using information from the CLID system to find a match of the stored EBC's which is then displayed). Further, it should be clear that the selection of the "information icon" via the user interface *fails completely* to describe that "*the priority associated with each data object is configured via a user interface*" as argued by the Office Action. Consequently, the Applicants respectfully suggest that the Office Action has mischaracterized the *Smith* reference with respect to the "pre-designated priority list."

Consequently, with respect to dependent claim 2, the Applicants respectfully suggest that the suggested *Smith* - *MS Win* combination reference fails to teach the elements of the claimed invention. Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of dependent claim 2, as cited above. Therefore, the Applicants respectfully traverse the rejection of dependent claim 2 under 35 U.S.C. §103(a) over *Smith* in view of *MS Win* in view of the non-obviousness of claim 2 , and therefore request reconsideration of the rejection of claim 2 under 35 U.S.C. §103(a).

1.3   Rejection of Claims 27-28, 31-39 and 42:

The Office Action rejected independent claim 27 under 35 U.S.C. §103(a), based on the rationale that the suggested *Smith - MS Win* combination reference discloses each of the elements of the Applicant's claimed "...process for automatically displaying contact information for contacts in an electronic address book..."

In general, the Office Action generally repeats the rejection offered with respect to claim 1 in addressing each of the elements of independent claim 27. Consequently, the arguments presented above with respect to the rejection of claim 1 are incorporated by reference into the arguments for the patentability of claim 27.

Specifically, in view of the preceding discussion, the Applicants also respectfully suggest that the suggested *Smith - MS Win* combination reference fails to teach a number of the elements of the Applicants' claimed invention related to automatic priority-based arrangement of data elements within a *non-predefined layout* in a display area, as disclosed and claimed in independent claim 27. Thus, the present invention, as claimed by independent claim 27, also has elements not taught in the *Smith - MS Win* combination reference.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 27, as cited above. Therefore, the Applicants respectfully traverse the rejection of independent claim 27, and thus of further dependent claims 28, 31-39 and 42, under 35 U.S.C. §103(a) over *Smith* in view of *MS Win* in view of the non-obviousness of claim 27, and therefore request reconsideration of the rejection of claims 27-28, 31-39 and 42, under 35 U.S.C. §103(a). In particular, claim 27 recites the following novel language:

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"A computer-implemented process for automatically displaying contact information for contacts in an electronic address book, comprising:

selecting a contact in the electronic address book via a user interface, said contact including at least one element of contact information, and *wherein each contact element includes an associated priority*;

providing a display area within a computer display device for displaying one or more elements of the contact information, and *wherein a layout of displayed elements of the contact information within the display area is not predefined*;

automatically determining and arranging a position of at least one of the-elements of the contact information within the display area for dynamically generating a priority-based layout of contact elements within the display area, using individual elements of the contact information *in order of higher priority to lower priority*, with lower priority elements of the contact information being displayed *only when available space exists within the display area*." (emphasis added)

1.4 Rejection of Claims 45-47 and 55:

The Office Action rejected independent claim 45 under 35 U.S.C. §103(a), based on the rationale that the suggested *Smith - MS Win* combination reference discloses each of the elements of the Applicant's claimed "...computer executable instructions for dynamically displaying a subset of at least one data element from a set of data elements on a computer display device..."

In particular, the Office Action states that claim 45 "is similar in scope to claims 1 and 27, and is therefore rejected under similar rationale." Consequently, the arguments presented above with respect to the rejection of claims 1 and 27 are incorporated by reference into the arguments for the patentability of claim 45.

Specifically, in view of the preceding discussion, the Applicants also respectfully suggest that the suggested *Smith - MS Win* combination reference fails to teach a number

of the elements of the Applicants' claimed invention related to automatic priority-based arrangement of data elements within a **non-predefined layout** in a display area, as disclosed and claimed in independent claim 45. Thus, the present invention, as claimed by independent claim 45, also has elements not taught in the **Smith - MS Win** combination reference.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 45, as cited above. Therefore, the Applicants respectfully traverse the rejection of independent claim 45, and thus of further dependent claims 46-47 and 55, under 35 U.S.C. §103(a) over **Smith** in view of **MS Win** in view of the non-obviousness of claim 45, and therefore request reconsideration of the rejection of claims 45-47 and 55, under 35 U.S.C. §103(a). In particular, claim 45 recites the following novel language:

A computer-readable medium having computer executable instructions for dynamically displaying a subset of at least one data element from a set of data elements on a computer display device, said computer executable instructions comprising:

automatically _assigning a priority to each data element_;

sorting the data elements in order of highest priority to lowest priority;

providing a display area within a computer display device for displaying one or more of the data elements, and **wherein a layout of displayed elements of the contact information within the display area is _not predefined_**; and

automatically _generating a layout for arranging and displaying as many of the data elements as will fit within the display area_ in order of **highest priority to lowest priority**, and wherein the displayed data elements comprise the displayed subset of at least one data element. (emphasis added)

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2.0   Rejections of Claims 5-6, 16, and 48-53 under 35 U.S.C. §103(a):

In the Office Action of June 17, 2004, claims 5-6, 16, and 48-52 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Smith** in view of **MS Win** in further view of Baldwin, et al. (U.S. Patent No. 6,496,201 B1, hereinafter "**Baldwin**").

However, as discussed above with respect to the rejection of claims 1 and 45, the proposed **Smith** - **MS Win** combination reference fails to teach or describe at least one of the elements of the Applicants claimed invention. Consequently, in view of the discussion provided above, it is clear that modifying the proposed **Smith** - **MS Win** combination reference through the addition of the **Baldwin** in an attempt to address particular features of dependent claims 5-6, 16, and 48-52 cannot serve to disclose the Applicants claimed invention where the **Smith** - **MS Win** reference relied on by the Office Action fails to disclose the parent claims.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claims 1 and 45, as cited above. Therefore, the Applicants respectfully request traverse the rejection of claims 5-6, 16, and 48-52, under 35 U.S.C. §103(a) over **Smith** in view of **MS Win** in further view of Baldwin in view of the non-obviousness of independent claims 1 and 45, as cited above, and therefore request reconsideration of the rejection of claims 5-6, 16, and 48-52, under 35 U.S.C. §103(a).

3.0   Rejections of Claims 20-22, 40-41, and 53-54 under 35 U.S.C. §103(a):

In the Office Action of June 17, 2004, dependent claims 20-22, 40-41, and 53-54 were rejected under 35 U.S.C. §103(a) as being unpatentable over the **Smith** reference in view of **MS Win**, and further in view of Shirakawa (U.S. Patent No. 5,956,738, hereinafter "**Shirakawa**").

However, as discussed above with respect to the rejection of claims 1 and 45, the proposed **Smith - MS Win** combination reference fails to teach or describe at least one of the elements of the Applicants claimed invention. Consequently, in view of the discussion provided above, it is clear that modifying the proposed **Smith - MS Win** combination reference through the addition of the **Shirakawa** in an attempt to address particular features of dependent claims 20-22, 40-41, and 53-54 cannot serve to disclose the Applicants claimed invention where the **Smith - MS Win** reference relied on by the Office Action fails to disclose the parent claims.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claims 1 and 45, as cited above. Therefore, the Applicants respectfully request traverse the rejection of claims 20-22, 40-41, and 53-54, under 35 U.S.C. §103(a) over **Smith** in view of **MS Win** in further view of **Shirakawa** in view of the non-obviousness of independent claims 1 and 45, as cited above, and therefore request reconsideration of the rejection of claims 20-22, 40-41, and 53-54, under 35 U.S.C. §103(a).

4.0   Rejections of Claims 24-25 and 43 under 35 U.S.C. §103(a):

In the Office Action of June 17, 2004, claims 24-25 and 43 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Smith** in view of **MS Win**, in further view of Fernandes (U.S. Patent No. 6,014,135, hereinafter "**Fernandes**").

The Office Action offers the **Fernandes** reference as disclosing the Applicants claimed elements relating to the use of pictures associated with particular data objects. However, as discussed above with respect to the rejection of claims 1 and 27, the suggested **Smith - MS Win** combination reference fails to teach or describe at least one of the elements of the Applicants claimed invention. Consequently, in view of the discussion

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provided above, it is clear that modifying the *Smith - MS Win* combination reference in an attempt to address particular features of dependent claims 24-25 and 43 cannot serve to disclose the Applicants claimed invention where the *Smith - MS Win* combination reference relied on by the Office Action fails to disclose the parent claims.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claims 1, and 27, as cited above. Therefore, the Applicants respectfully request traverse the rejection of claims 24-25 and 43 under 35 U.S.C. §103(a) over *Smith* in view of *MS Win* and in further view of *Fernandes*, and therefore reconsideration of the rejection of these claims in view of the non-obviousness of independent claims 1 and 27, as cited above.

5.0   Rejections of Claims 26 and 44 under 35 U.S.C. §103(a):

In the Office Action of July 22, 2003, claims 26 and 44 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Smith* in view of *MS Win* in view of *Fernandes* and further in view of *Shirakawa*.

In particular, the Office Action offers the *Smith - MS Win* combination reference reference as disclosing the use of priorities assigned to the pictures disclosed by *Fernandes*. However, as discussed above with respect to the rejection of claims 1 and 27, the *Smith - MS Win* combination reference fails to teach or describe the use of priority-based arrangement of data objects for filling the available space on a computer display device, among other things. Consequently, modifying the *Smith - MS Win* combination reference in an attempt to address particular features of dependent claims 26 and 44 cannot serve to disclose the Applicants claimed invention where the *Smith - MS Win* combination reference relied on by the Office Action fails to disclose the parent claims.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claims 1, and 27, as cited above. Therefore, the Applicants respectfully request traverse the rejection of claims 26 and 44 under 35 U.S.C. §103(a) over **Smith** in view of **MS Win**, in view of **Fernandes**, and in further view of **Shirakawa**, and therefore request reconsideration of the rejection of these claims in view of the non-obviousness of independent claims 1 and 27, and of dependent claims 24 and 43, respectively, as cited above.

6.0   Rejection of Claims 29-30 under 35 U.S.C. §103(a):

In the Office Action of July 22, 2003, claims 29-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over the **Smith** reference in view of **MS Win** and in further view Cushman, et al. (U.S. Patent No. 6,125,287, hereinafter "**Cushman**").

However, as discussed above with respect to the rejection of claim 27, the **Smith** - **MS Win** combination reference fails to teach or describe the use of priority-based arrangement of data objects for filling the available space on a computer display device, among other things. Consequently, modifying the **Smith** - **MS Win** combination reference in an attempt to address particular features of dependent claims 29-30 cannot serve to disclose the Applicants claimed invention where the **Smith** - **MS Win** combination reference relied on by the Office Action fails to disclose the parent claim.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 27, as cited above, as well as the novel language of claims 29-30. Therefore, the Applicants respectfully traverse the rejection of claims 29-30 under

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35 U.S.C. §103(a) over **Smith** in view of **MS Win**, and in further view of **Cushman**, and therefore request reconsideration of the rejection of these claims in view of the non-obviousness of independent claim 27.

7.0   Rejection of claims 56-57 under 35 U.S.C. §103(a):

In the Office Action of June 17, 2004, claims 56-57 were rejected under 35 U.S.C. §103(a) as being unpatentable over the **Smith** - **MS Win** combination reference.

In particular, the Office Action offers the **Smith** - **MS Win** combination reference as disclosing "automatically arranging and displaying as many of the data elements as will fit within a display area on the computer display device in order of highest priority to lowest priority...," and suggests that the use of pre-designated categories for shading or color coding particular displayed data elements would be obvious.

However, as discussed above with respect to the rejection of claim 45, the **Smith** - **MS Win** combination reference fails to teach or describe the use of priority-based arrangement of data objects for filling the available space on a computer display device, among other things. Consequently, in view of the discussion provided above, it is clear that taking "official notice" for further modifying **Smith** in an attempt to address particular features of dependent claims 56-57 cannot serve to disclose the Applicants claimed invention where the **Smith** - **MS Win** combination reference relied on by the Office Action fails to disclose the parent claim.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 45, as cited above. Therefore, the Applicants respectfully traverse the rejection of claims 56-57 under 35 U.S.C. §103(a) over **Smith** in view of **MS**
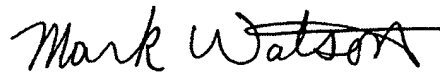
Win, and therefore request reconsideration of the rejection of these claims in view of the non-obviousness of independent claim 45, as cited above.

CONCLUSION

In view of the above, it is respectfully submitted that claims 1-57 are in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of claims 1-57, and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (805) 278-8855 if the Examiner has any questions or concerns.

Respectfully submitted,

Lyon & Harr
300 Esplanade Drive, Suite 800
Oxnard, California 93036
(805) 278-8855

Mark A. Watson
Registration No. 41,370
Attorney for Applicant